



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 14

Richard F Lemuth
Shell Oil Company
PO Box 2463
Houston, TX 77252-2463

COPY MAILED

JUL 12 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of
Willink et al.
Application No. 09/869,632
Filed: June 28, 2001
Attorney Docket No. TH-1456 (US) DSC:SWT

This is a decision on the petition under 37 CFR 1.183, filed February 2, 2004, requesting waiver of the rules and transfer of a CPA from application no. 09/869,654 to the instant application. This is also a decision on the petition filed in the alternative under 37 CFR 1.137(b), to revive the above-identified application.

The petition under 37 CFR 1.183 is **dismissed**.

The petition under 37 CFR 1.137(b) is **dismissed**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

Facts:

On April 14, 2003, Notices of Allowance and Notices of Allowability were mailed for the instant application and application no. 09/869,654. Both applications pertain to similar subject matter. The sole inventor for application no. 09/869,654 is the first named inventor for the instant application. Shell Oil Company is the party prosecuting both applications. The titles of the applications, although not identical, are similar.

A request for a CPA and IDS were filed on May 22, 2003.

Petitioner intended for the CPA and IDS to be filed in the instant application. Unfortunately, the heading of the request for the CPA listed the application number as 09/869,654. The correct application number, and the title for the instant application, can be found on the front page of the request for CPA.

The CPA request was placed in the file for application no. 09/869,654.

Due to the timing of the CPA, the common subject matter of the applications, and perhaps other factors, the examiner failed to note the CPA was meant for another application.

The IDS was considered and a non-final rejection was mailed on October 21, 2003, for application no. 09/869,654.

The petition fails to allege the examiner was informed the CPA had been placed in the wrong file after petitioner received the non-final Office action.

A response to the October 21, 2003 Office action was filed on March 1, 2004.

The examiner subsequently allowed application no. 09/869,654.

Meanwhile, having received no response in the instant application, the Office mailed a Notice of Abandonment on August 19, 2003.

The instant petition was mailed to the Office on January 29, 2004.

The petition under 37 CFR 1.183:

An example of a case which *might* warrant relief under 37 CFR 1.183 follows:

- (1) a CPA is filed using an incorrect number due to a typographical error, and
- (2) the application is abandoned and the CPA cannot be entered.

Another example:

- (1) a CPA and IDS are filed using an incorrect number due to a typographical error,
- (2) the title listed on the cover page of the CPA is drastically different than the incorrect application's title,
- (3) the subject matter of the IDS does not relate to the subject matter of the incorrect application, and
- (4) the examiner notes the CPA is in the wrong file and does not continue prosecution based on the CPA.

In this case, the subject matter of the applications failed to clearly indicate to the examiner the CPA was not intended for the file. The title listed on the front page does not differ to such an extent that a quick glance or review would indicate a problem. The examiner continued prosecution after considering the contents of the IDS and sent a non-final Office action as a result of the CPA.¹ The CPA resulted in continued examination by the examiner and allowed petitioner the opportunity to amend the application to the extent desired in response to the non-final Office action. Petitioner did in fact amend the application and the application, as amended, has now been allowed.

Transferring the CPA from the other application would involve not only the transfer of papers and fees, but the invalidation of all subsequent prosecution for that application including the response filed on March 1, 2004. If one were to transfer the CPA, then application no. 09/869,654 would be abandoned unless proof were supplied that the issue fee was timely submitted. Even if petitioner proved the fee had been submitted, an issue would remain whether or not a petition to withdraw from issue, RCE, and IDS should be filed since the examiner probably thought the prior art cited in the IDS meant for the other case was relevant since the examiner responded with a non-final office action rather than another Notice of Allowance.

The petition has failed to address the reason the examiner was not immediately notified of the erroneous filing of the CPA upon receipt of the non-final Office action. The petition fails to address the reason the instant petition was not filed until more than five months after the mailing of the Notice of Abandonment. In general, a petition should be filed within two months. See 37 CFR 1.181.

¹ The Office assumes the examiner would not have withdrawn the Notice of Allowance and reopened prosecution if petitioner had simply waited and paid the issue fee.

Moreover, petitioner has a suitable remedy on hand for his predicament, that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that "justice" does not require an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought even if the other avenue is more expensive. In this case, the relief sought - entry of the "CPA" and IDS - can be obtained by the filing of a petition under 37 CFR 1.137(b), the "CPA", and the IDS.

In order for a petition under 37 CFR 1.183 to be granted, petitioner must demonstrate the existence of an extraordinary situation where justice requires waiver of one or more federal regulations. All the facts have been considered, along with the impact of granting relief on the prosecution of the other application. The evidence which has been supplied is insufficient to establish that waiver is proper.

The petition under 37 CFR 1.137(b).

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance mailed April 14, 2003, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on July 14, 2003. A Notice of Abandonment was mailed on August 19, 2003

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply,
- (2) the petition fee,
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional,² and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The instant petition lacks item (1).

The IDS cover sheet was filed with the petition. However, Form PTO-1449 referenced on the cover sheet, and any of the documents which might be listed on the Form, cannot be located in the file. The Form and copies of the documents should be filed.

Continued Prosecution Application (CPA) practice has been abolished. Therefore, if the CPA were entered, it would automatically be treated as a RCE. However, since the CPA filed in the instant application has not been entered as of this date, and the petition is being dismissed based on other grounds, the Office requests that petitioner submit a form clearly intended as a RCE to replace the CPA request. A form which may be used for this purpose is attached.

The renewed petition must be accompanied by the issue fee. The submission of a RCE (and fee) and IDS as the proposed reply is insufficient. While the revival of applications abandoned for failure to timely prosecute and for failure to timely pay the issue fee are incorporated together in 37 CFR 1.137, the statutory provisions for the revival of an application abandoned for failure to timely prosecute and for failure to timely submit the issue fee are mutually exclusive.³ 35 U.S.C. 151 authorizes the acceptance of a delayed payment of the issue fee, if the issue fee "is submitted ... and the delay in payment is shown to have been unavoidable." 35 U.S.C. 41(a)(7) likewise authorizes the acceptance of an "unintentionally delayed payment of the fee for issuing each

² Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

³ See Brenner v. Ebbert, 398 F.2d 762, 157 USPQ 609 (D.C. Cir. 1968).

patent." Thus, 35 U.S.C. 41(a)(7) and 151 each require payment of the issue fee as a condition of reviving an application abandoned or patent lapsed for failure to pay the issue fee. A reply that serves to continue prosecution in an application, such as a RCE, is not sufficient to satisfy either §151 or 41(a)(7), and the Commissioner does not have the authority to waive these statutory requirements. Accordingly, the filing of a request for continued examination without payment of the issue fee or any outstanding balance thereof is not an acceptable reply in an application abandoned or patent lapsed for failure to pay the issue fee or any portion thereof. Where an application is abandoned for failure to pay the issue fee, the proposed reply required for revival must include payment of the issue fee.

Petitioner is advised that, if the above-identified application is again allowed, petitioner may request that any issue fee amount paid with the renewed petition be applied towards the issue fee required by the new Notice of Allowance.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: (703) 872-9306
 Attn: Office of Petitions

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.



Charles Steven Brantley
Petitions Attorney
Office of Petitions

Attached: PTO/SB/30